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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,436	07/16/2001	Hermann Wagner	C1041/7010	1340

7590 11/08/2005

Alan W Steele
Wolf Greenfield & Sacks
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210-2211

EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/786,436

Applicant(s)

WAGNER ET AL.

Examiner

Brian Whiteman

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

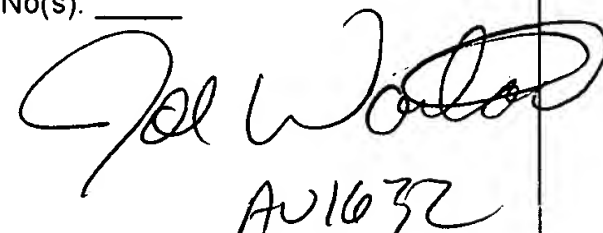
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: 114.
Claim(s) rejected: 104-110, 112 and 113.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.


AW1632

Continuation of 11. does NOT place the application in condition for allowance because: In response to applicant's argument that there is no teaching, suggestion, or motivation provided by McKay and/or Schlom to combine a method of downregulating JNK with a method in which JNK may be upregulated as these methods appear to be mutually contradictory. The argument is not found persuasive because the argument has already been addressed in the previous office action. See pages 4-7 of office action mailed on 7/7/05.

In response to applicant's argument that applicant remind the examiner of the priority date of the instant application and the Arbour and Sabapathy reference cited by the examiner are post-filing, the examiner acknowledges that these references were articles published in 2001-2002 and the US application was filed on 7/16/01 and has priority back to 9/98. The post-filing art may be relied upon to show the level of ordinary skill in the art at or around the time the invention was made. Ex parte Erlich, 22 USPQ 1463 (Bd. Pat. App. & Inter. 1992).

In response to applicant's argument that Sabapathy serves only to bolster applicant's position that McKay cannot and would not be combined with Schlom rather than the examiner's position with respect to McKay and Schlom, the argument is not found persuasive because there is no evidence of record that administration of SEQ ID NO: 24 being delivered to a sufficient amount of immune system cells and targeting JNK in a sufficient amount of cells to inhibit the immune system's response to an antigen. See In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). There are 3 types of JNKs and Sabapathy teaches that JNK1 and JNK2 control similar functions during T cell maturation through differential targeting of distinct substrates. This would indicate to one of ordinary skill in the art that JNK1 and JNK2 would not both respond to SEQ ID NO: 24 since they have two different pathways to control T cell maturation.

In response to applicant's argument that Arbour provides a direct teaching away not only from Sabapathy but also McKay, the argument is not found persuasive because Sabapathy is not recited in the 103 rejection of record. Sabapathy and Arbour are only cited to show the level of ordinary skill in the art at or around the time the invention was made and to address applicant's arguments and show that there is more than one type of JNK.

In response to applicant's argument that the combination of McKay and Schlom is not proper and they do not comprise a "method" and the examiner has not properly made even a hypothetical enablement rejection, the argument is not found persuasive because MPEP 2144.06 states, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). This is the case here. McKay teaches using SEQ ID NO: 24 to kill tumor cells in a mammal and Schlom teaches using a tumor specific antigen to kill tumor cells.

In response to applicant's argument that applicant has made reasoned arguments based on analysis of what the references cited by the examiner actually teach, rather than merely making an assertion about "what seems to follow from common experience", the argument is not found persuasive because the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.").

Applicant's argument that for the record applicant submits that the finality of the office action mailed on 7/7/05 is improper because of the citation of Sabapathy and Arbour by the examiner represents new grounds of the rejection under 103. The argument is not found persuasive because the articles were cited to respond to applicant's argument and were not used in the 103 rejection of record. See MPEP 706.07(a).

Continuation of 13. Other: A one month extension fee has been charged to account 23/2825 because the response was filed after the 3 month date 10/1/05 and the response was filed in the 4 month.